

Appl. No. 10/060,622
Amdt. Dated August 31, 2005
Reply to Office Action of July 19, 2005

Docket No. IR105465
Customer No. 23330

REMARKS

Claims 1-8, 10-18 and 20-22 remain in the application. The actions taken are in the interest of expediting prosecution and with no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled in view of the prior art. Moreover, the amendment or cancellation of claims herein is without prejudice to pursuing claims of different scope by way of continuing Application. Reconsideration of this application is respectfully requested.

I. STATUS OF CLAIMS

1. Claims 1-8 and 10-12 stand rejected under U.S.C. §103(a) as being unpatentable over Mitzenmacher et al. (U.S. Patent No. 5,953,503, hereinafter Mitzenmacher) in view of Hamiti et al. (U.S. Patent No. 6,751,209, hereinafter Hamiti et al.).
2. Claims 13-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mitzenmacher in view of Hamiti and in further view of Lee et al. (U.S. Patent No. 6,807,173, hereinafter Lee).
3. Claims 9, 19 and 23-29 are cancelled.

II. SUMMARY OF INVENTION

The present invention pertains to pre-placing data elements from an Session Initiation Protocol (SIP) header into a template located on the far end of a link between a client application and a server.

III. ISSUES

(1) Whether claims 1-8 and 10-12 are made obvious by Mitzenmacher in view of Hamiti under 35 U.S.C. 103(a).

(2) Whether claims 13-22 are made obvious by Mitzenmacher in view of Hamiti and in further view of Lee under 35 U.S.C. 103(a).

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IV. ARGUMENTS

35 U.S.C. § 103

Claims 1-8 and 10-12 stand rejected under U.S.C. §103(a) as being unpatentable over Mitzenmacher et al. (U.S. Patent No. 5,953,503, hereinafter Mitzenmacher) in view of Hamiti et al. (U.S. Patent No. 6,751,209, hereinafter Hamiti et al.). Claims 13-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mitzenmacher in view of Hamiti and in further view of Lee et al. (U.S. Patent No. 6,807,173, hereinafter Lee).

Applicants' respectfully traverse the rejection and request reconsideration. It is incumbent upon the Examiner to prove a *prima facie* case of obviousness (MPEP 2143). To establish a *prima facie* case three basic criteria must be met. First, the prior art reference must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Finally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference.

The cited art does not teach or suggest the claimed limitations:

Applicant's independent claims 1 and 16 call for, among other things, generating a compressed message related to the template message, wherein generating comprises: providing a service request message identifier within the compressed message; providing a template on/off flag within the compressed message; and providing a template index within the compressed message, wherein generating the compressed message references the message template at the far end communication system without using the message template to generate the compressed message. Support for the additional language can be found in cancelled claims 9 and 19, and on page 4 lines 14-20 of the specification. As the message template is located at the server/far end communication system, the compressed message is not generated using the message template, but merely refers to the message template.

Mitzenmacher teaches a method of compressing web pages through the use of a preset dictionary to both compress and decompress a web page (abstract, column 2 lines 19-30). When a user requests a web page, Mitzenmacher teaches the use of a preset dictionary (located at both

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the client and server units), to compress and decompress a message requesting the web page (column 2 lines 58-65). Further, the preset dictionary is used to initialize the encoding and decoding process for messages requesting web pages between a client and server (column 3 lines 21-33). The Examiner equates the preset dictionary of Mitzenmacher to the message template of Applicant's recited claims. *But is clear that the template of Applicant's recited claims is very different from the preset dictionary of Mitzenmacher, as the preset dictionary must be used to compress and decompress a message. This is contrasted with Applicant's recited limitations where a template is merely referenced by a compressed message, with the template being at the receiving end (server/far end communication system). Further, Applicant's compressed message does not rely on the message template during the generation step.*

In addition, Mitzenmacher does not teach or suggest the claimed limitations of a service request message identifier, a template on/off flag or a template index within the compressed message. The Examiner alleges that Mitzenmacher teaches a service request message identifier by equating the finger print identifier of Mitzenmacher to the recited limitation of a request message identifier. Applicant's respectfully disagree. The service request identifier message recited by Applicant's identifies the kind or type of message, for instance an SIP invite message (see Applicant's specification, page 9 lines 10-16). This is contrasted with the finger print identifier of Mitzenmacher which is used to identify a preset dictionary (column 4, lines 20-38). These are clearly different identifiers with entirely different functions.

The Examiner alleges that Mitzenmacher teaches a template with an on/off flag within the compressed message. Applicant's respectfully disagree. The Examiner cites column 2 line 66 to column 3 line 11, column 3 lines 22-33 and lines 43-52 of Mitzenmacher. Column 3 lines 43-52 teaches the indication of a compression type and dictionary used in a message header. This is not the same as the template on/off flag recited by Applicants. The template on/off flag is an indication of whether the particular message is a template or not (see Applicant's specification page 9, lines 17-22). This is reinforced by the fact that Mitzenmacher does not teach the use of a template at all, let alone a template on/off flag. The other portions cited by the Examiner to support the template on/off flag contain no references to anything even remotely similar.

The Examiner alleges that Mitzenmacher teaches a template index. Applicants' respectfully disagree. The template index is a number which tells the far end, typically a server, which particularly pre-placed template is to be reconstructed (see Applicant's specification, page

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9 lines 23-29). This is contrasted with the Examiner's references to Mitzenmacher that merely teaches the use of the dictionary to initialize the encoding and decoding processes, an indicator of the type of compression used, and a fingerprint to identify a preset dictionary. None of these equate to the template index since Mitzenmacher does not teach or suggest a pre-placed template, let alone a template index as recited by Applicants.

Hamiti teaches a method of transferring a data packet by sending a data packet comprising information on header fields that vary during the data transfer and information for relating a received compressed value to a corresponding compression sequence and updating the information according to received compression values (abstract). Hamit does not make up for the deficiencies of Mitzenmacher and therefore does not teach or suggest the claimed limitations of a service request message identifier, a template on/off flag or a template index within the compressed message.

Lee teaches compressing an SIP header using tokenization and a standard compression algorithm such as LZ77 (abstract). The teachings of Lee do not make up for the deficiencies in Mitzenmacher.

In sum, it is clear that neither Mitzenmacher, Hamiti nor Lee teach or suggest generating a compressed message related to the template message, wherein generating comprises: providing a service request message identifier within the compressed message; providing a template on/off flag within the compressed message; and providing a template index within the compressed message, wherein generating the compressed message references the message template at the far end communication system without using the message template to generate the compressed message.

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. See In Re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). In addition, a *prima facie* case of obviousness cannot be found unless all the elements of the claim are taught or suggested by the cited art. In Re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). See also In Re Wilson, 424 F. 2d 1382, 165 U.S.P.Q.2d 494 (C.C.P.A. 1970) ("All words in a claim must be considered in judging patentability of the claim against the prior art."). As the Examiner has not found a teaching or suggestion in Mitzenmacher, Hamiti or Lee for all the elements in independent

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claims 1 and 16, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case obviousness based upon these prior art references.

The relied on references do NOT teach toward each other:

Before obviousness may be established, the Office Action *must show specifically* the principle, known to one of ordinary skill that suggests the claimed combination. *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). In other words, the Examiner *must explain* the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention. *Id.* The factual question of motivation is material to patentability and *cannot be resolved based on subjective belief and unknown authority*. *Id.* at 1344. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). The critical inquiry is whether there is something in the prior art as a whole *to suggest* the desirability, and thus the obviousness, of making the combination. *Fromson v. Advance Offset Plate*, 755 F.2d 1549, 1556 (Fed. Cir. 1985). The Office Action *fails to show either a suggestion in the art or a compelling motivation based on sound scientific principles to combine the references and therefore the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn*. Applicants respectfully submit that there is no suggestion to combine the references, and if they could be properly combined, do not lead to the Applicants' invention.

The Examiner states that Mitzenmacher suggests the "exploration of art" and/or a reason to modify the message compression method. The Applicant's respectfully disagree. For support, the Examiner cites column 2 lines 58-65, column 4 lines 34-46 and column 5 lines 11-15. The column 2 reference merely supports Applicant's assertion that Mitzenmacher does not teach Applicant's recited limitations does not specifically suggest the exploration of any other methodologies. The column 4 reference discusses fingerprinting for identifying a preset dictionary, but again does not specifically suggest exploration of alternative compression methods. Finally, the column 5 reference is a vague reference to modifications of Mitzenmacher but does not specifically teach in any direction or any combination of art, and certainly not in the direction of Hamiti or any other alternate compression means.

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It is respectfully submitted that even assuming *arguendo* that all the elements of these claims are taught or suggested by the cited art, the Examiner has also failed to provide some teach, suggestion or incentive supporting the combination of Mitzenmacher, Hamit. Rather, any support of this two reference combination is limited to the Examiner's assertion that the two references are "analogous art." However, obviousness cannot be established by combining teachings of the prior art to produce the claimed invention, absent some teaching or incentive supporting the combination. (See In Re Geiger, 815 F.2d 686, 2 U.S.P.Q.2d 1276, 1278). *Moreover, when the incentive to combine the teachings of the references is not readily apparent, it is the duty of the Examiner to explain why combination of the reference teachings is proper and absent such reasons or incentives, the teachings of the references are not combinable.* (See Ex parte Skinner, 2 U.S. P.Q.2d, 1788, 1790 (B.P.A.I. 1986)) Furthermore, it is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claims invention is rendered obvious (i.e., one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to duplicate the claimed invention.) (See In Re Fritch, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992) (quoting In Re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

In view of the foregoing, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case obviousness because all the elements of the claim are taught or suggested by the cited art, there is no teaching, suggestion or incentive supporting the combination, and duplication of the claims elements from the cited art is based upon hindsight. Accordingly, it is respectfully submitted that the rejection of Claims 1 and 16, and the claims that depend from these two claims, under 35 U.S.C. §103(a) is improper, and the Examiner is respectfully requested to withdraw the rejections under U.S.C. §103(a).

Prior Art

The references cited but not relied upon are believed not to anticipate or make obvious Applicants' invention.

Summary

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No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Applicants believe that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicants.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

Accordingly, this application is believed to be in proper form for allowance and an early notice of allowance is respectfully requested.

Please charge any fees associated herewith, including extension of time fees, to 502117, Motorola, Inc..


Respectfully submitted,

SEND CORRESPONDENCE TO:

Motorola, Inc.
Law Department

Customer Number 23330

By:


Kevin D. Wills
Attorney of Record
Reg. No.: 43,993
Telephone: 480-732-5364
Fax No.: 480-732-2402